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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GREGORY J. PETRAS, JEFFREY T. ZYWICKI, FLORI N.  
PARHAM, MARK A. FISHER, ROBERT R. MARTIN, ANDREW F.  
MASON, CORY OSBORN, LISA J. CRAMER, CRAIG P. THOMPSON,  
NORMAN WHITE, GARY D. MELLOTT, KIMBERLY A. CAMERON,  
KORY KREDIT, RACHAEL A. THOMAS, CONNIE RIFFEL, and  
RICHARD W. HILL

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Appeal 2009-006522  
Application 10/624,345<sup>1</sup>  
Technology Center 2100

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Decided: June 1, 2010

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*Before* JOHN A. JEFFERY, LEE E. BARRETT, and JAY P. LUCAS,  
*Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> Application filed July 22, 2003. Appellants claim the benefit under 35 U.S.C. § 119 and § 120 of various applications dating to February 10, 2000. The real party in interest is Involve Technology, Inc.

### STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 35, 36 and 43 to 85 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claims 1 to 34 and 37 to 42 have been withdrawn from consideration.

We affirm the rejections.

Appellants' invention relates to a system and method for maintaining a database of information using user opinions (Spec. 1, middle). The system can develop questionnaires for acquiring user opinions of products or services and can help users find information on products and services from other users (*id.*). In the words of Appellants:

A system for automatically creating and maintaining a database of information utilizing user opinions about subjects, particularly exceptional experiences. Described is an Internet system assisting/motivating a population of users interested in information about certain categories of subjects to automatically maintain the database content and to improve the usefulness and quality of the database information without any substantial management by the website owner-manager. The user opinions are primarily in the form of both comments and ratings about which natural-language terms best describe a particular subject, enabling user searches of the subject database to be by way of preferred such descriptive natural language terms, which terms are further preferred to be evaluative and approving.

Also, a system for automatically creating and maintaining a database of information utilizing user knowledge about sales related subjects.

Described is an Internet-based system for assisting/motivating a population of users interested in information about certain categories of sales related subjects to automatically maintain the database content and to improve the usefulness and quality of the database information without any substantial management by the website owner-manager. The user opinions are primarily in the form of both comments and ratings of which sales related subjects best provide assistance in completing a sale.

(Spec. 146)

Claims 35 and 43 are exemplary, and are reproduced below:

- 35) An Internet website client-server computer system, for use to determine by e-mail survey a level of subject approval for each one of a population of survey participants by capturing each such participant's opinions about the degree of relevance of each of a respective set of natural language terms to each of a respective set of subjects, comprising:
- a) a client interface system arranged so that a survey taker may indicate at least
    - i) a defined question for the survey,
    - ii) a such set of subjects to be evaluated,
    - iii) a such set of natural-language terms to be rated as to relevancy to each subject,
    - iv) a participant audience, and
    - v) a time-frame for response;

- b) a server computer processor system connected with said client interface system; and
  - c) a server computer software system, operational with said server computer processor system, arranged to provide survey processing comprising
    - i) compiling a survey file and survey document in accordance with survey taker input,
    - ii) communicating such survey document to such participant audience, and
    - iii) receiving and tabulating responses.
- 43) An Internet client-server system for assisting at least one group of users having at least one common goal to capture and search, in a single database, offered knowledge, relevant to such at least one common goal, of a plurality of such users for the benefit of at least one of such users, comprising:
- a) individually capturing for such database at least one experience of at least some of such plurality;
  - b) storing in such database such experience;
  - c) user-searching, using at least one natural-language word, to select at least one desired kind of stored experience;
  - d) performing such user-searching; and
  - e) presenting search results.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Yong	US 5,749,079	May 05, 1998
Nielsen	US 5,948,054	Sep. 07, 1999
Hill	US 6,029,192	Feb. 22, 2000
Ng	US 6,405,175 B1	Jun. 11, 20002
Hamlin	US 6,477,504 B1	Nov. 05, 2002

### REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 45, 47 to 49, 52, 54 to 56, 58, 60, 61, 63, 66, 68, 70, 72 to 74, 76, 78, 79, 81 and 83 stand rejected under 35 U.S.C. § 112 for being indefinite.

R2: Claims 35 and 36 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Hamlin.

R3: Claims 43 to 45, 48, 49, 52, 56 and 57, plus 64 to 66, 68, 70, 74 and 75 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Hill.

R4: Claims 46, 47, 50, 51, 53 to 55, 58 and 59 plus 67, 69, 71 to 73, 76, 77 and 82 to 85 stand rejected under 35 U.S.C. § 103(a) for being obvious over Hill in view of Ng.

R5: Claims 60 to 62 plus 78, 79 and 80 stand rejected under 35 U.S.C. § 103(a) for being obvious over Hill in view of Yong.

R6: Claims 63 plus 81 stand rejected under 35 U.S.C. § 103(a) for being obvious over Hill in view of Nielsen.

For each rejection in the rejection summary above, the claims listed after the word “plus” were indicated as being rejected by the respective

rejections listed in the Examiner's clarification in the Answer, pages 20 to 30. Appellants' submission concerning an impropriety of the format of the Examiner's rejections is deemed to be a petitionable matter, and not within the jurisdiction of this tribunal (App. Br. A18, top).

Appellants contend that the claims are not indefinite. Appellants also contend that Hamlin and Hill do not each anticipate the claimed subject matter, and that Hill in combination with Ng, Yong and Nielsen do not teach limitations in the claims. The Examiner contends that each of the claims is properly rejected.

We will review the rejections in the order argued and as grouped in the Briefs. We have only considered those arguments that Appellants actually raised in the Briefs. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## ISSUES

The issues are whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112, paragraph 2; 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). The claims present a number of occurrences where the antecedent basis of a term may be unclear. In addition, a prior art rejection hinges on whether the references Hamlin and Hill teach the surveying, storing and accessing of user experiences as claimed.

### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system and method for accumulating, storing and retrieving data on all manner of products and services, leisure activities and experiences (Spec 5, middle). One aspect of this voluminous application on which the claims focus is an automated system for distributing surveys to subjects, and accumulating the responses for a client (Spec. 57, middle). Another aspect is the assignment of natural language descriptive words relevant to a specified subject (Spec 56, middle). Searching is based on these descriptions (Id.)
2. The Hamlin reference teaches a mechanism for automated survey creation and distribution (Col. 2, l. 55). The mechanism permits clients to generate questionnaires (Fig. 3) with natural language terms that are evaluated by the survey participants (Fig. 4, Col. 7, l. 55). Results are tabulated and posted on a web page for the client (Col. 10, ll. 27 to 29).
3. The Hill reference teaches a generalized system for sharing evaluations of products, services and experiences (Col. 3, ll. 5, 37). Evaluations of resources are made by users and posted for others to consider (Col. 5, ll. 2, 25).



## PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

"A reference does not fail as an anticipation merely because it does not contain a description of the subject matter of the appealed claim in ipsissimis verbis." *In re May*, 574 F.2d 1082, 1090 (CCPA 1978) (citing *In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978)).

"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)).

“Indefiniteness under 35 U.S.C. § 112 ¶ 2 is an issue of claim construction and a question of law that we review de novo.” *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009) (citing *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008)).

For post-prosecution analysis, our guiding courts use the following analysis:

Patent claim is not invalid for indefiniteness unless it is insolubly ambiguous; therefore, if meaning of claim is discernible, claim is sufficiently clear to avoid invalidity on indefiniteness grounds, even if interpreting claim is difficult, and construction is one over which reasonable persons could disagree.

*Bancorp Services LLC v. Hartford Life Insurance Co.*, 359 F.3d 1367 (Fed. Cir. 2004).

However, during prosecution before this Office, while Appellants still have the opportunity to amend the claims, a higher standard of clarity is required:

In particular, rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

*Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

## ANALYSIS

From our review of the administrative record, we find that the Examiner presents the conclusions of unpatentability on pages 3 to 30 of the

Examiner's Answer. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection  
of claims 45, 47 to 49, 52, 54 to 56, 58, 60, 61, 63, 66, 68, 70, 72 to 74, 76,  
78, 79, 81 and 83  
under 35 U.S.C. § 35 U.S.C. § 112 (para. 2) [R1]*

The Examiner has rejected the noted claims for diverse reasons. We will consider this rejection claim by claim:

Claims	Analysis
45, 66	We agree that the claimed term “substantially” in the context of the degree to which a website management system is “substantially automatic” is indefinite. Appellants point to the Specification, page 98, line 32, for supporting the definition for the term (App. Br. A10, middle). However, even in the Specification there is no delineation of which management functions would be performed by the system, and which would be reserved for the administrator. In building a competing software/ hardware system, a future inventor would never be sure whether the supplying of a certain automated function would overstep the boundary of the system management being “substantially automatic.” We thus hold “substantially automatic” in these claims to be indefinite. <i>See In re Nehrenberg</i> , 280 F.2d 161, 165 (CCPA 1960). The scope of the claim term “substantially” must be sufficiently defined in the Specification ( <i>id.</i> at 165). In the instant application,

“substantially automatic” as claimed was not sufficiently defined to make certain the scope of the claim.

47 We agree with the Examiner that the term “such population of users” and “such management community” are indefinite, lacking a clear antecedent basis. Claim 47 and its parent claims mention groups of users, pluralities of users, and some of such pluralities of users. It is simply not clear which population or community is being referred to in claim 47.

48-49, 68 The limitations “such knowledge of users” and “such group of users” could refer to any of a number of users and groups of users in the parent claims to which the noted phrases may refer. We agree with the Examiner these claims are not clear.

52, 70 We disagree with the Examiner with respect to the limitation “if any” being indefinite. A limitation may be conditional, and may leave open the situation where the condition is not satisfied. We recommend that “if any” be located after the word “experience,” but will not support the rejection.

54, 72 We agree with the Examiner that the term “such at least one user” is indefinite, as, in the context of the claim, the “at least one user” could be one of many users in the parent claims. We also agree that “such accumulated points” is unclear, as the user who accumulated the points is not unambiguously specified.

55, 73 We agree with the Examiner that there is no reference for “such computer software”.

- 56, 74        We agree with the Examiner that “one item of experience” has no defined antecedent in the claim or in the parent claims. Likewise, there is no antecedent for “involved subset”.
- 58, 76        These claims lack an antecedent for “such set of performance goals,” “such population of users,” and “such reward system,” as expressed by the Examiner.
- 60, 78        The terms “such at least one user,” and “such at least one predetermined category” lack antecedent basis in the claim or in the parent claims.
- 61, 79        The term “such pre-determined information” does not necessarily refer to the more general term “knowledge” and thus lacks antecedent basis.
- 63, 81        No “such at least one user” is unambiguously expressed, in the claims or their parents.

We also agree with the Examiner (Ans. 3, bottom) that the term “such” is not a clear reference to an antecedent term – “said” is much preferable as it makes a specific reference to the antecedent of the term in question. “Such” is less definite and we are not aware that this term has an accepted meaning in claim interpretation.

*Arguments with respect to the rejection  
of claims 35 and 36  
under 35 U.S.C. § 102(e) [R2]*

The Examiner has rejected claims 35 and 36 for being anticipated by Hamlin. The Appellants demur, contending that “Hamlin fails to disclose

any survey involving ‘a such set of subjects to be evaluated’ and ‘a such set of natural-language terms to be rated as to relevancy to each survey’”, as claimed (App. Br. A12, middle). Examples of such experiential subjects to be evaluated as disclosed by the Appellants are “a succulent steak, a cozy campsite.” (*Id.*). Examples of Appellants’ descriptive words are “tasty, romantic, friendly service.” (*Id.*).

Hamlin teaches a system for automating the creation, distribution and analysis of surveys over the Internet (Fig 2A; col. 2, ll. 54 to 64). The actual subject matter of the surveys are not material to the rejection, as the claims mention no more than “subjects to be evaluated”. However, we note that the Hamlin reference is adapted for surveying related to marketing generalized products, such as toothpaste (Col. 1, l. 48). The adjectival natural-language evaluation terms in the Hamlin reference are chosen by the client, who specifies the survey himself (Col. 8, l. 2). In the table in column 8, line 25, natural language terms such as reading, sleeping, working etc. are evaluated, relevant to a subject, such as enjoyable pursuits. In summary, we find that Hamlin teaches subjects to be evaluated and relevant sets of natural language terms rated as to relevancy to each subject.

We find no error in the Examiner’s rejection of claims 35 and 36, for the reasons stated above and for the reasons stated by the Examiner (Ans. 34, top).

*Arguments with respect to the rejection  
of claims  
43 to 45, 48, 49, 52, 56 and 57, plus 64 to 66, 68, 70, 74 and 75  
under 35 U.S.C. § 102 [R3]*

The Examiner has rejected the noted claims for being anticipated by Hill, which teaches a system for storing and retrieving information about experiences with products and services (Col. 2, ll. 61 to 68). Appellants argue that Hill “does not disclose storing in any database user experiences or user-searching, using at least one natural-language word, to select at least one desired kind of store experience.” (App. Br. A14, middle).

We adopt and agree with the Examiner’s analysis of the teachings of the Hill reference with respect to claim 43. Hill clearly teaches searching on user experiences, best exemplified by entries concerning river rafting in the Rocky Mountain National Park or related experiences (col. 11, l. 17). Hill teaches each of the steps recited in the claim, capturing, storing, searching, presenting, and thus anticipates it. (*See* Ans. 8 and 9.)

With respect to the features of dependent claims 48, 49 and 56, we agree with and adopt the Examiner’s response, and do not find error in the rejections (Ans. 35, middle; Ans. 11, top).

*Arguments with respect to the rejection  
of claims 46, 47, 50, 51, 53 to 55, 58 and 59 plus 67, 68, 71 to 73, 76, 77  
and 82 to 85 [R4]  
and of claims 60 to 62 plus 78, 79 and 8 [R5]  
and of claims 63 plus 81 [R6]  
under 35 U.S.C. § 103(a)*

The Examiner has rejected the noted claims for being obvious over Hill, and respectively Ng, Yong and Nielsen. Against each of these rejections the Appellants have only stated that the secondary reference fails to overcome the deficiencies of Hill. As we have not found the anticipation rejection over Hill to be deficient, we will not find error in applying Hill to the respective rejections under 35 U.S.C. § 103(a).

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 35, 36 and 43 to 85 under rejections R1 – R6.

#### DECISION

This Board decides as follows:

R1: The rejection of claims 45, 47 to 49, 54 to 56, 58, 60, 61, 63, 66, 68, 72 to 74, 76, 78, 79, 81 and 83 under 35 U.S.C. § 112 paragraph 2 for being indefinite is affirmed. The rejection under 35 U.S.C. § 112 paragraph 2 of claims 52 and 70 is reversed.



R2: The rejection of claims 35 and 36 under 35 U.S.C. § 102(e) for being anticipated by Hamlin is affirmed.

R3: The rejection of claims 43 to 45, 48, 49, 52, 56 and 57, plus 64 to 66, 68, 70, 74 and 75 under 35 U.S.C. § 102(e) for being anticipated by Hill is affirmed.

R4: The rejection of claims 46, 47, 50, 51, 53 to 55, 58 and 59 plus 67, 68, 71 to 73, 76, 77 and 82 to 85 under 35 U.S.C. § 103(a) for being obvious over Hill in view of Ng is affirmed.

R5: The rejection of claims 60 to 62 plus 78, 79 and 80 under 35 U.S.C. § 103(a) for being obvious over Hill in view of Yong is affirmed.

R6: The rejection of claims 63 plus 81 under 35 U.S.C. § 103(a) for being obvious over Hill in view of Nielsen is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2009-006522  
Application 10/624,345

peb

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